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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,890	04/14/2004	Thomas C. Sloan	772-27-007	7320
23935	7590	07/24/2006	EXAMINER	
KOPPEL, PATRICK & HEYBL 555 ST. CHARLES DRIVE SUITE 107 THOUSAND OAKS, CA 91360			TRUONG, BAO Q	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/624,690	Applicant(s) SLOAN ET AL	
	Examiner Bao Q. Truong	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 14-16, 19-38, 47 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17, 18 and 39-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 6 is objected to because of the following informalities: "its" should be changed to what it refers. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-9, 11-13, 17 and 39-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Cleaver et al. [US 6,592,238].

Regarding claim 1, Cleaver et al. discloses an elongated flexible lighting system [10] having an array of light sources [24] being illuminated by electric power, and an elongated translucent extrusion of flexible material [12] dispersing light from the light sources [24] (figures 1-3, column 6 lines 4-22).

Regarding claims 2, 7 and 40, Cleaver et al. discloses the array of light sources [24] being cuttable at intervals (can be separated) (figure 18).

Regarding claim 3, Cleaver et al. discloses LEDs [24] (figure 2).

Regarding claim 4, Cleaver et al. discloses a linear array of LEDs [24] (figure 2).

Regarding claims 5 and 41, Cleaver et al. discloses a plurality of parallel connected sub-arrays of LEDs (figure 18).

Regarding claims 6 and 42, Cleaver et al. discloses a plurality of voltage regulators [234, 242] (figure 18).

Regarding claim 8, Cleaver et al. discloses a mounting means [40, 42] (figure 12).

Regarding claim 9, Cleaver et al. discloses a bracket [40] (figure 12).

Regarding claim 11, Cleaver et al. discloses means [resistor] for conducting the electrical power from the lighting system to another device [236] (figure 18).

Regarding claims 12, 13 and 43, Cleaver et al. discloses a PCB [26] being vertically mounted integral to the extrusion [12] (figure 3).

Regarding claim 17, Cleaver et al. discloses the extrusion [12] comprising silicone (column 5 line 48, column 1 line 22).

Regarding claim 39, Cleaver et al. discloses an elongated flexible lighting system [10] having an array of light sources [24] being illuminated by electric power, a plurality of electrical power regulators [234, 242], and an elongated translucent extrusion of flexible material [12] dispersing light from the light sources [24] (figures 1-3 and 18, column 6 lines 4-22).

Regarding claims 44-46, Cleaver et al. discloses an elongated flexible lighting system [10] having an array of LEDs [24] being illuminated by electric power, a PCB [26] inheritance having conductive traces, which are on a surface of the PCB having

different angles or directions, for electrical connection, and an elongated translucent extrusion of flexible material [12] dispersing light from the LEDs [24] (figures 1-3, column 6 lines 4-22).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cleaver et al. in view of Camarota [US 6,186,645].

Regarding claim 10, Cleaver et al. discloses an extrusion [12] and a mounting means including a bracket [40] and a fastener [42] (figure 12). Cleaver does not disclose the extrusion including one or more longitudinal grooves and the bracket having one or more lips, each lip arranged to mate with grooves.

Camarota discloses a flexible lighting system having an extrusion [612, 614] including grooves [at flanges 616 and 618] and a bracket [710] with lips [715, 714] (figures 6-7).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the mounting means of Cleaver et al. with the grooves and bracket with lips as taught by Camarota to secure each other for purpose of providing an advantageous way of attaching a flexible lighting system to a surface.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cleaver et al. in view of Slayden [US 6,361,186].

Regarding claim 18, Cleaver et al. discloses the extrusion [12] (figure 3) but does not disclose a longitudinal cavity.

Slayden discloses a flexible lighting system including a diffusion extrusion [10, 11] including a longitudinal cavity [at 21] (figure 1 and 2, column 3 lines 1-15).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the extrusion of Cleaver et al. with the longitudinal cavity as taught by Slayden to diffuse light for purpose of providing an advantageous way of producing uniform light.

### ***Response to Arguments***

7. Applicant's arguments filed on 6/7/2006 have been fully considered but they are not persuasive. The applicant recites claim 1 includes a "flexible material" that provides a number of advantages over the solid rod design described in Cleaver et al. However, Cleaver et al. discloses the device [10] with a waveguide [12] being use of a flexible material so that the device [10] can be easily be deformed and bent into the desired shape (column 5 lines 4-22, column 6 lines 4-7). Moreover, applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., once said bending force is removed, the lighting system 10 provides a further advantage by returning to its former straight

condition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, it has been held by the courts that selection of a prior art material on the basis of its suitability for its intended purpose is within the level of ordinary skill. *In re Leshing*, 125 USPQ 416 (CCPA 1960) and *Sinclair & Carroll Co. v. Interchemical Corp.*, 65 USPQ 297 (1945).

In view of above independent claims 1, 39, 44 and their dependency are unpatentable.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Q. Truong whose telephone number is (571) 272-2383. The examiner can normally be reached on Monday-Friday (8:00 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bao Q. Truong  
Examiner  
Art Unit 2875

  
ALBERT CARIASO  
PRIMARY EXAMINER